

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 33

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HOWARD W. DEMOORE
and JOHN A. BRANSON

Appeal No. 1997-4428
Application 08/259,634

HEARD: FEBRUARY 8, 2000

Before BARRETT, FLEMING, and BARRY, **Administrative Patent Judges.**

FLEMING, **Administrative Patent Judge.**

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1 through 5, 8 through 11, 14 through 16, 24 through 31, 34 through 39, and 42 through 51. Claims 19 through 23, 40, 41, and 52 through 57 are withdrawn from consideration. Claims 6, 7, 12, 13, 17, 18, 32 and 33 are objected to, for depending upon a rejected claim.

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The invention relates to a method and apparatus for providing improved support for freshly printed sheet material in a printing press.

Independent claim 1 is reproduced as follows:

1. A method for supporting sheet material which has been freshly printed in a printing press, comprising the steps of:

providing a rotatable member having a sheet support surface thereon;

providing a base covering of electrically conductive material having a frictional coefficient which is less than the frictional coefficient of the sheet support surface;

securing the conductive base covering to the rotatable member in contact with the sheet support surface;

providing a jacket covering of flexible material;

securing the flexible jacket covering over at least a part of the conductive base covering; and,

turning the rotatable member to support successive sheets of the freshly printed sheet material on the flexible jacket covering.

The Examiner relies on the following references:

Kobler	4,599,943	July 15,
1989		
DeMoore et al. (DeMoore)	5,042,384	Aug.
27, 1991		

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Claims 1 through 5, 8 through 11, 14 through 16, 24 through 31, 34 through 39, and 42 through 51 stand rejected under 35 U.S.C. § 103 as being unpatentable over DeMoore in view of Kobler.

Rather than reiterate the arguments of Appellants and the Examiner, reference is made to the briefs¹ and answer for the respective details thereof.

OPINION

We will not sustain the rejection of claims 1 through 5, 8 through 11, 14 through 16, 24 through 31, 34 through 39, and 42 through 51 under 35 U.S.C. § 103.

The Examiner has failed to set forth a ***prima facie*** case. It is the burden of the Examiner to establish why one having ordinary skill in the art would have been led to the claimed invention by the express teachings or suggestions found in the prior art, or by implications contained in such teachings or suggestions. ***In re Sernaker***, 702 F.2d 989, 995, 217 USPQ 1, 6

¹ The Appellants filed an appeal brief on February 19, 1997. Appellants filed a reply brief on November 10, 1997. On July 9, 1998, the Examiner mailed a communication stating that the reply brief has been entered and considered.

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(Fed. Cir. 1983). "Additionally, when determining obviousness, the claimed invention should be considered as a whole; there is no legally recognizable 'heart' of the invention." *Para-Ordnance Mfg. v. SGS Importers Int'l, Inc.*, 73 F.3d 1085, 1087, 37 USPQ2d 1237, 1239 (Fed. Cir. 1995)(*citing W. L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1548, 220 USPQ 303, 309 (Fed. Cir. 1983), **cert. denied**, 469 U.S. 851 (1984)).

On page 3 of the answer, the Examiner states that DeMoore fails to teach that the base covering 62 is electrically conductive. The Examiner argues that Kobler recognizes that an undesirable electrostatic charge is built up on the surface of rubber cylinders in the printing press during the printing operation and teaches to provide an electrically conductive layer 6 on the base covering 4 connected to the cylinder body, which is grounded, in an effort to carry away the electrostatic charge build up on the cylinder surface. The Examiner directs us to the drawing figure and col. 2, line 10, through col. 3, line 26, of the Kobler reference. The Examiner argues that it would have been obvious to one of

ordinary skill in the art at the time the invention was made to provide the base covering 62 of DeMoore

with an electrically conductive layer connected to the cylinder body as taught by Kobler so as to alleviate the electrostatic charge build up problem on the cylinder surface.

Appellants argue on page 12 of the brief, that there is no suggestion or motivation to substitute Kobler's aluminum conductive layer 6 in the place of DeMoore's non-conductive base covering 62. Appellants argue that Appellants' claims require a conductive layer in direct contact with the covering net or jacket. Appellants point out on pages 10 and 11 of the brief that Kobler discloses a blanket cylinder with a rubber blanket 5, a felt underlay packing 4, a non-conductive Teflon coating 3 and an aluminum conductive layer 6.

Appellants argue that Kobler teaches that the aluminum conductive layer 6 prevents the build up of the electrostatic charge on the rubber blanket 5. The conductive aluminum layer is insulated from the blanket cylinder by the non-conductive

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felt Teflon coating layer 3. Additionally, the conductive layer 6 is insulated from the rubber blanket 5 by the packing underlay 4 which is to be constructed of paper, cardboard or felt.

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Appellants argue that Kobler, therefore, does not teach a direct contact with the underlying conductive material as required by Appellants' claims.

The Federal Circuit states that "[t]he mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." **In re Fritch**, 972 F.2d 1260, 1266 n.14, 23 USPQ2d 1780, 1783-84 n.14 (Fed. Cir. 1992)(**citing In re Gordon**, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984)). The Federal Circuit reasons in **Para-Ordnance Mfg. v. SGS Importers Int'l**, 73 F.3d 1085, 1088-89, 37 USPQ2d 1237, 123940 (Fed. Cir. 1995), **cert denied**, 519 U.S. 822 (1996), that for the determination of obviousness, the court must answer whether one of ordinary skill in the art who sets out to solve the problem and who had before him in this workshop the prior art, would have been reasonably expected to use the solution that is claimed by the Appellants.

In col. 1, lines 14 through 37, Kobler teaches that it is necessary or desirable to cover the surface of the rubber

blanket cylinder with a protective coating since the cylinder is in

contact with aggressive chemicals. Kobler discloses that typical coatings are nickel, chromium, and alloys as well as electrically non-conductive materials, such as ceramic, Teflon or silicone. Kobler states that it has been found that a coating on the rubber blanket cylinder which is electrically non-conductive or only poorly conductive causes in due course damage to the surface of the cylinder. In col. 1, lines 45 through 56, Kobler states that it appears that the damage to the cylinder may be due to electrostatic charge which will build up on the blanket and which cannot be conducted away from the surface of the cylinder if the surface is non-conductive or electrically only poorly conductive. In col. 2, lines 10 through 21, Kobler teaches that the figure shows a rubber blanket cylinder C having a surface 1 which is coated with a protective coating 3 of electrically non-conductive or only semiconductive material, which is applied in order to protect the surface of the cylinder 1 from attack by corrosive

or chemically aggressive materials. In col. 2, lines 22 through 33, Kobler discloses that a pad 4 is applied to the surface of the rubber blanket cylinder. The pad may be made of paper, cardboard, felt, or the like. The pad 4 is beneath the rubber blanket 5. In col. 2, lines 34 through 62, Kobler teaches that it has been found that electrostatic charge will build up on the insulating material forming the pad 4 and the blanket 5.

Kobler teaches that the surface of the pad 4 which is in contact with the insulating protective layer has an electrically conductive layer or coating 6 applied thereon. Therefore, we find that Kobler teaches that the electrically conductive layer 6 is between the pad 4 and the protective coating 3 of the cylinder surface 1.

Thus, we find that Kobler is concerned with drawing off electrostatic charges that could be built up in between a pad 4 and protective layer 3 to prevent damage due to corrosion. Kobler is not concerned with the problem of electrostatic charge building up on the outer surface of the rubber blanket 5. Therefore, we fail to find any suggestion or desirability

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of placing Kobler's electrical conductive layer 6 in between DeMoore's base covering 62 and the flexible jacket covering 78. We fail to find that DeMoore or Kobler recognizes the problem of electrical static charge building up between the base covering and the flexible jacket covering.

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In view of the foregoing, we have not sustained the rejection of claims 1 through 5, 8 through 11, 14 through 16, 24 through 31, 34 through 39, and 42 through 51 under 35 U.S.C.

§ 103. Accordingly, the Examiner's decision is reversed.

REVERSED

LEE E. BARRETT)	
Administrative Patent Judge)	
)	
)	
)	BOARD OF PATENT
MICHAEL R. FLEMING)	
Administrative Patent Judge)	APPEALS AND
)	
)	INTERFERENCES
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LANCE LEONARD BARRY)	
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